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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,877	01/14/2004	Thomas P. Feist	08CN8803-28	5188
23413	7590	04/24/2006	EXAMINER	
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			KIM, PAUL D	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/757,877	Applicant(s) FEIST ET AL.	
	Examiner Paul D. Kim	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/15/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is a response to the election of species filed on 2/15/2006.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly submitted claim 22 filed on 4/14/2005 including a limitation "deposing a thermoset coating on a side of the plastic surface opposite the core" as recited in lines 1-2 was not described in the specification as originally filed and appear to be new matter.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase of "deposing a thermoset coating on a side of the plastic surface opposite the core" as recited in lines 1-2 renders the claim vague and indefinite. It is unclear as to where the side surface of the plastic surface opposite the core is indicated.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Sandstrom (US PAT. 5,972,461).

Sandstrom teaches a process of making an optical data storage disk comprising steps of: injection molding a substrate, which could be formed from two or more layers bonded together such as laminating (equivalent with coating, as per claim 22) with materials such as thermoset (as per claim 20), thermoplastic, metal or glass (as per claim 19) (col. 7, lines 4-6), wherein one of the two or more layers can be a plastic having a plastic surface and another of the two or more layers can be a core; disposing a reflective layer (14) on a surface of the substrate as shown in Fig. 1; wherein the data

storage media has an axial displacement peak of less than about 62 microns under shock or vibration excitation (see also col. 11, lines 4-54).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 21, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandstrom (US PAT. 5,972,461) in view of Marchon (US PAT. 6,055,140).

Sandstrom teaches all of the limitations as set forth above except a material for the plastic surface. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to apply the material as recited in the claimed invention because Applicant has not disclosed that the material as recited in the claimed invention provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with Sandstrom because the material as recited in the claimed invention would perform equally well such as thermoset or thermoplastic material for the substrate in Sandstrom. Therefore, it would have been an obvious matter of design choice to modify the thermoset or thermoplastic material of Sandstrom to obtain the invention as specified in claim 21.

According to Fig. 3 of Sandstrom, in the manufacturing the recording medium, it is well known in the art to provide the thickness of the disk in the range of 0.6 mm to 2.0 mm. Therefore, it would also have been an obvious matter of design choice to a person of ordinary skill in the art to modify the thickness of the disk of Sandstrom to obtain the claimed invention as specified in claims 23 and 24.

Response to Arguments

9. Applicant's arguments with respect to claims 18-24 have been considered but are moot in view of the new grounds of rejection.

10. Applicant's arguments filed 2/15/2006 have been fully considered but they are not persuasive. Applicant argues that paragraphs [0046], [0048] and [0053]-[0055] of the specification clearly taught the limitation of "deposing a thermoset coating on a side of the plastic surface opposite the core" as recited in lines 1-2 of claim 22. Examiner traverses the argument that there is no such a description where the side of the plastic surface opposite the core is located. Therefore, the recitation was not described in the specification as originally filed and appear to be new matter. Also, applicant argues that the prior art of record fails to teach the core. Examiner traverses the argument.

Sandstrom teaches that the substrate can be made by two or more layers bonded together such as laminating and the materials used for the substrate are thermoset, thermoplastic, metal or glass. Also, there is no further structural definition in the claimed what the core is made of or where the core is. Therefore, one of the two or more layers of Sandstrom can be a plastic surface made of plastic material (such as thermoset) and

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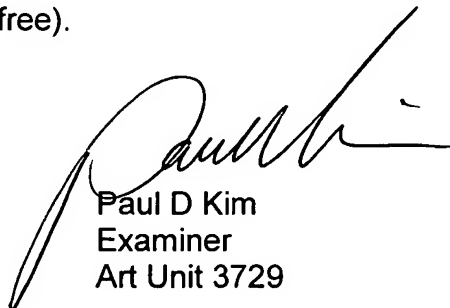
another of the two or more layers can be a core made of either thermoset, thermoplastic, metal or glass.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D. Kim whose telephone number is 571-272-4565. The examiner can normally be reached on Monday-Friday between 6:00 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul D Kim
Examiner
Art Unit 3729